Paper No. 37

UNITED STATES BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR E. BOGDEN and
JACQUES-PIERRE MOREAU

Appeal No. 96-2471
Application No. 08/089,410[1]

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134 of the final rejection of claims 6 to 11, 16, 18, and 19 (Notice of Appeal, Paper 28).

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[1] Application 08/089,410, filed 9 July 1993, which is said to be a continuation of Application 07/652,863, filed 8 February 1991.

Upon consideration of Appellants' Brief on Appeal (Paper 31), the Examiner's Answer (Paper 32), Appellants' Reply Brief (Paper 33), the Supplemental Examiner's Answer (Paper 34), and the Appellants' Supplemental Reply Brief (Paper 35), we reverse

the rejection of claims 6 to 11, 16, 18, and 19 as being unpatentable under 35 U.S.C. § 103 in view of Souquet, Morgan, Doepfner, Bauer, and Camisa. With all due respect to the Examiner's position, we seriously doubt that one skilled in the art would have been motivated to modify the subcutaneous treatment described by Souquet and make it into a topical treatment without the benefit of knowledge found only in Appellants' disclosure. On this record, it is Appellants who first disclose the concept that melanomas express somatostatin receptors[2]. The prior art relied upon by the Examiner does not teach or suggest the concept. It is improper to rely on Appellants' disclosure as motivation for combining the prior art. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the

[2] See Appellants' Specification at Page 1.

insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."); In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (obviousness judgments are necessarily based on hindsight; so long as judgment takes into account only knowledge known in the art, there is no error.).

REVERSED

SHERMAN D. WINTERS)
Administrative Patent Judge)
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WILLIAM F. SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND

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